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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/556,978	04/24/2000	Young-Nam OH	1317-D1/MDS	6968

21171 7590 05/20/2004

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WASHINGTON, DC 20005

EXAMINER
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MILLER, BRIAN E

ART UNIT	PAPER NUMBER
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2652

DATE MAILED: 05/20/2004

23

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application

09/556,978

Applicant(s)

OH ET AL.

Examiner

Brian E. Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 19, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 19, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 22.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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Claims 1-3, 19, 23-24 are now pending.

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 4/6/04 has been entered.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-3, 19, 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art (AAPA), FIG. 1, in view of Oshima et al (US 5,526,328). The

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AAPA, as depicted in FIG. 1 and described on page 2, lines 8-20, teaches the following: (as per claims 1, 19, 23 & 24) a hybrid disc including a substrate; a label printed surface (A) formed on the substrate; a first recording surface (B, the CD layer), the first recording surface being formed at a first interval below the label printed surface; a second recording surface (C, the DVD layer) formed at a second interval below the label printed surface; wherein the second interval is longer than the first interval, i.e., the DVD layer is further down; wherein from the above structure it is least inherent that first and second recording surfaces (B & C) are accessible for recording or reproduction from the same surface of the disc, i.e., from the bottom, opposite the label side, since the laser would not penetrate the label as known in the art; (as per claim 2) the AAPA further discloses the hybrid disc wherein the first recording surface is a CD recording surface on which CD data is recorded (layer B), and said second recording surface is a DVD recording surface on which DVD data is recorded (layer C).

As set forth in claims 1, 3 & 19, the AAPA does not disclose having an ID information in a predetermined area indicating the type of disk that it is, e.g., TOC. Oshima et al, however, discloses a hybrid disc configuration (see col. 57, lines 23-40) which teaches that an HB (hybrid) identifier is stored in the TOC area, such that the HB recording medium can be identified upon the first reading of the TOC area information. From this teaching in a hybrid disc, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided such information in the TOC area of the hybrid disc of the AAPA.

The motivation would have been: identifying that the type of disc was a hybrid disc quickly would have been important for proper operation of the disc and contents thereon, as taught by Oshima et al (see col. 57, lines 36-40).

***Response to Amendment***

While the comments by Applicant's counsel at the Board hearing, i.e., regarding the reference to US Patent 5,526,328, prompted the refiling of the application (RCE), the amendments made to the claims do not address the teaching of the aforementioned reference, nor are arguments made in view of the teachings thereof. The Examiner has consequently made an art rejection using the teachings of this reference, as they are considered very pertinent to the pending claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Miller whose telephone number is (703) 308-2850. The examiner can normally be reached on M-TH 7:15am-4:45pm (and every other friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "B. Miller", with a stylized flourish at the end.

**Brian E. Miller**  
**Primary Examiner**  
**Art Unit 2652**

Bem  
May 12, 2004